Supreme Court, U.S.
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No. 05-950

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In The Supreme Court of the United States

RON NYSTROM,

Petitioner,

v.

TREX COMPANY, INC. and
TREX COMPANY, LLC,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI WITH APPENDIX

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QUESTIONS PRESENTED

1. Whether the Federal Circuit is correct in holding that there are no underlying factual inquiries involved in a district court's patent claim construction and, therefore, all aspects of the district court's claim construction are subject to *de novo* review on appeal.

2. Whether the Federal Circuit's current method of claim construction in patent cases, as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), is in conflict with this Court's precedent prohibiting the reading of limitations from the patent's specification into the claims.

3. Whether the Federal Circuit's application of *Phillips* in this case is in conflict with this Court's precedent prohibiting the reading of limitations from the patent's specification into the claims.

RULE 14.1(b) STATEMENT

Pursuant to Supreme Court Rule 14.1(b), Petitioner Ron Nystrom states that all parties to the proceedings below appear in the caption of the case on the cover page.

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Fed. R. Civ. P. 52(a) 1, 14, 16, 18

OTHER AUTHORITIES

Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 20

Bender, *Uncertainty And Unpredictability In Patent Litigation: The Time Is Ripe For A Consistent Claim Construction Methodology,* 8 J. INTELL. PROP. L. 175 (2001) 27

Burgess, Comment, *Simplicity At The Cost Of Clarity: Appellate Review Of Claim Construction And The Failed Promise Of Cybor,* 153 U. PA. L. REV. 763 (2004) 28

Dunner & Kwon, *Cybor Corp. v. FAS Technologies: The Final Say on Appellate Review of Claim Construction?,* 80 PAT. & TRADEMARK OFF SOC'Y 481 (1998) 27

Fahmi & Dreszer, *De Novo Review Of Claims Construction Or Wasted Effort Of The District Court,* 19 SANTA CLARA COMPUTER & HIGH TECH. L.J. 315 (2002) 28

Foster & Kessel, *Phillips Leads To A Different Result In 'Nystrom,'* NAT. LAW JOURNAL S3 (Dec. 5, 2005) 28

Gallagher, *The Federal Circuit And Claim Construction: Resolving The Conflict Between The Claims And The Written Description,* 4 N.C. J. L. & TECH. 121 (2002) 27-28

H.R. Rep. No. 312, 97th Cong., 1st Sess. 20-23 (1981) 10, 15

Moore, *Are District Court Judges Equipped To Resolve Patent Cases?,* 15 HARV. J. LAW & TEC. 1 (2001) 27

Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?,* 9 LEWIS & CLARK L. REV. 231 (2005) 28

Rooklidge & Weil, *Judicial Hyperactivity: The Federal Circuit's Discomfort With Its Appellate Role,* 15 BERKLEY TECH. L.J. 725 (2000) 27

Staheli, Comment, *Deserved Deference: Reconsidering The De Novo Standard Of Review For Claim Construction,* 3 MARQ. INTELL. PROP. L. REV. 181 (1999) 27

Zura, *Looking For Fire Amidst The Smoke – Is The Federal Circuit Really Exceeding Its Authority In Patent Infringement Cases?,* 12 BALT. INTELL. PROP. L.J. 1 (2003) 28

PETITION FOR A WRIT OF CERTIORARI

CITATIONS OF OPINIONS AND ORDERS

The initial opinion of the panel of the court of appeals dated June 28, 2004 is reported at 374 F.3d 1105 (Fed. Cir. 2004). App. at 30A. On September 14, 2005, the panel entered an unpublished order withdrawing that opinion and granting panel rehearing. App. at 91A. On the same day, the panel issued a second opinion reported at 424 F.3d 1136 (Fed. Cir. 2005). App. at 1A. The district court's unpublished order and opinion on claim construction was entered on August 19, 2002. App. at 74A. The order and opinion of the district court granting summary judgment of non-infringement and order and opinion granting partial summary judgment of invalidity against petitioner were entered on September 11, 2002, and October 17, 2002, respectively, and are unpublished. App. at 68A, 57A. The district court's unpublished amended judgment dated October 20, 2003 was entered *nunc pro tunc* October 25, 2002. App. at 93A.

JURISDICTION

The jurisdiction of the district court was invoked under 28 U.S.C. §§ 1331 and 1338(a). The jurisdiction of the court of appeals was invoked under 28 U.S.C. § 1295(a)(1). A panel of the court of appeals entered its initial opinion on June 28, 2004. The panel withdrew its initial opinion and entered a new opinion and a judgment on September 14, 2005. Petitioner timely filed a petition for panel rehearing and rehearing *en banc*, which was denied by the court of appeals in an order entered November 1, 2005. App. at 90A. This Court has jurisdiction under 28 U.S.C. § 1254(1).

RULES AND STATUTES INVOLVED

The first question presented implicates Federal Rule of Civil Procedure 52(a), which states:

> In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. It will be sufficient if the findings of fact and conclusions of law are stated orally and recorded in open court following the close of the evidence or appear in an opinion or memorandum of decision filed by the court. Findings of fact and conclusions of law are unnecessary on decisions of motions under rule 12 or 56 or any other motion except as provided in subdivision (c) of this rule.

The second and third questions presented implicate 35 U.S.C. § 112, which states:

> The specification shall contain a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.